

REMARKS

1. GENERAL

All pending claims in the present application (Claims 1-40) are rejected under 35 U.S.C. § 103(a).

2. SECTION 103 REJECTIONS

Claims 1-3, 6-7, 11-14, 17-18, 22-25, 28, 32-34, 37, and 40 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 5,732,398 issued to Tagawa ("*Tagawa*") in view of U.S. Patent Number 5,047,614 issued to Bianco ("*Bianco*"), U.S. Patent Number 6,249,773 issued to Allard et al. ("*Allard et al.*") or U.S. Patent Number 6,550,672 issued to Tracy et al. ("*Tracy et al.*"). Claims 4-5, 8-9, 15-16, 19-20, 26-27, 29, 35-36, and 38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tagawa* in view of *Bianco*, *Allard et al.* or *Tracy et al.* and further in view of U.S. Patent Number 5,832,452 issued to Schneider, et al. ("*Schneider*"). Claims 10, 21, 30, and 39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tagawa* in view of *Bianco*, *Allard et al.* or *Tracy et al.* and further in view of Isaacson, et al (WO 00/19351) ("*Isaacson*"). Applicants traverse these rejections for the reasons stated below.

Claim 1 is allowable over the combinations of *Tagawa* and *Bianco*, *Allard et al.* or *Tracy et al.* because the combinations do not teach or suggest "a reservation engine operable to...communicate a list of the hotels meeting the parameters, the list including at least one generic hotel listing; receive a reservation request for a hotel associated with a generic hotel listing; and create a reservation according to the reservation request," as recited by Claim 1.

The Examiner concedes that *Tagawa* does not specifically disclose a list that includes a generic hotel/item (Office Action at page 3). The Examiner, however, asserts that any of *Bianco*, *Allard et al.*, or *Tracy et al.* teach the presentation of shopping lists including generic items. This is incorrect for a number of reasons.

Bianco describes a system whereby the consumer enters items desired to be purchased into a memory by scanning barcodes associated with the specific items found on containers, coupons, advertisements, and/or pamphlets furnished by a store. This accumulated memory is then read by a terminal, in the store for example, that will compile a shopping list or may actually transmit the order for fulfillment. The reference to a "generic" item in *Bianco* in the manner that the Examiner cites, relates to the preparation of a list of "a number of frequently purchased items, by brand or generic names, such as listing 22 for 'MILK.' Opposite listing 22 is a unique barcode 24 which corresponds to listing 22." In *Bianco*, therefore, the use or reference to a "generic name" is merely to provide a shorthand notation for a product already identified as previously purchased or fully described to the consumer.

Allard, et al. describes a method and system for shopping over a network that includes providing stored shopping lists that permit the user to select items previously identified on the shopping list. *Allard et al.* further describes the methods and systems necessary for consummating the purchase of products and delivering the purchased products to the shopper. The Examiner references the description of column 74 shown in FIG. 2 of the *Allard et al.* patent wherein the list of products is provided. In the description of FIG. 2 the specification states "Column 74 includes the item description, including brand, package size and price per unit." (emphasis added) (Column 7, lines 3-5). Reference is also made to FIG. 5 and a description of

the screen provided to the purchaser that highlights "Specials of the Day" for the online store. The specification states "each entry can include a picture and a word description of the product as shown by reference number 110." (Column 8, lines 51 - 53.) In no event is the shopper presented with a "generic description" of any product among the lists provided in *Allard et al.*

Tracy et al. provides a method and system that generate and display a customer preference list containing a large variety of information. Included in this information (column 9, lines 25-30) are described "generic brand alternatives." It is clear, however, from the list provided in *Tracy et al.* that "generic brand alternatives" refers to products that in fact have no brand name (disguised or undisguised) but are simply generic as opposed to branded. This can be seen by the subsequent items in the preference list shown at column 9, lines 24-60 that include "brand name alternatives" and "better buy alternatives."

The distinction that becomes apparent from a review of the above-cited references is a distinction in the use of the term "generic." Each of the references *Bianco*, *Allard et al.* and *Tracy et al.* may be distinguished on this definitional basis. The Examiner has cited, for example, the non-patent document *Franz, Julie*; Ten Years May Be Generic Lifetime; 1989; Advertising Age; Web Copy 4 Pages, that specifically identifies the use of "no name products" that were in fact unbranded and never became branded to the consumer. This is distinct from the "generic description" of a product as that term is utilized in the claims of the present invention. In the present case a "generic description" or reference to a "generic hotel" means a generically described hotel rather than an unbranded and never to be branded hotel or product. This is made clear in the present application specification by reference to the purpose of providing a generic description as opposed to a specific brand name description of the product (the hotel room). The

purpose is, as described, the avoidance of comparison price shopping for the same product, thus allowing a brand name product to be sold at a discount rate without jeopardizing the sale of that same product at a standard rate. The generic description, as used in the present application, is all such information about a product that informs the consumer about the quality of the goods and services without specifically identifying, or allowing the consumer to identify, the brand name.

The use of the term generic in *Tracy et al.* specifically refers to the type of generic product described in the *Franz* publication mentioned above. It is not a generic description of a branded product but rather a product that in fact has no brand and which can be directly compared by the consumer with other products that do bear brand names. The consumer has no expectation that at some point in the purchasing process the brand of the “generic” product will be disclosed. In fact, it is the very expectation that no brand is associated with a product that allows the consumer to bear the risk (and benefit from the lower price) associated with a product of generally unknown quality.

Allard et al. in fact makes no reference to the use of either “generic brands” or even “generic descriptions.” The above quotes from *Allard et al.* referenced by the Examiner specifically state that the list includes a column (Column 74 in FIG. 2) that includes the “item description including brand, package size, and price per unit.” Nothing in this list is identified or even implied to be a generic description or a generic product. Likewise, in an association with the “Specials of the Day” identified in a separation presentation to the user, nothing is identified as being generic and in fact very specific descriptions of the product including a picture description of the product are presented to the user. Nowhere in *Allard et al.* is the consumer expected to make a choice with regard to an unbranded product.

Bianco again describes a system whereby a consumer can accumulate a history of purchases and generate either shopping lists or shopping orders by selecting from the historically generated list. *Bianco* makes specific reference (column 3, lines 15-20) to "lists of a number of frequently purchased items, by brand or generic names." In the manner utilized in *Bianco* therefore, the term generic means a shorthand description of a product already purchased by the consumer. In other words, no doubt is left in the consumer's mind as to the specific product being purchased even though a generic description of the product is utilized. This is because of the accumulation of the information and the provision of the product on the list in the first place, is based on the user's historical purchases of the very specific product (as identified by the barcode for that product). Here again, therefore, in *Bianco* no doubt is left in the consumer's mind as to the specific brand that is presented on the list even though the product may be generically described as a shorthand means for providing the shopping list to the consumer.

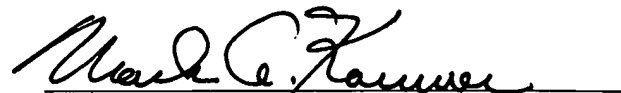
In none of the above cited references is the consumer presented with a generic description of a product or service for the purpose of disguising a branded product or service. The use of the term generic, therefore, as used in each of the cited references, is distinct from the manner in which the term is utilized in the present application. As utilized in each of the claims pending, the term "generic hotel" always relates to a branded hotel whose identity is being withheld until the purchase has been consummated. Again, this is specifically for the purpose of allowing the branded product to be sold at a discount price without allowing direct comparison shopping to occur with the branded product at its standard price. None of the cited references utilize the term in this manner and none teach the use of presenting generic descriptions of a product or service to the consumer with the expectation that the brand name of the product or service would be disclosed after consummation of the sale. The use of the term "generic" in Claim 1 therefore

relates to the "un-named branded" product rather than an "un-branded" product. Because of this distinction, it would further not be appropriate for one skilled in the art to look to any of *Bianco*, *Allard et al.* or *Tracy et al.* for the purpose of contributing a "generic" listing to the system of *Tagawa*.

For reasons analogous to those provided in conjunction with the discussion of Claim 1, Claims 12, 23, and 32 are also allowable. Re-consideration and favorable action are requested. Furthermore, as depending from allowable independent Claims 1, 12, 23, and 32, their respective dependent Claims 2-11, 13-22, 24-31, and 33-40 are also allowable. Re-consideration and favorable action are requested. Should any further impediments to allowance remain, Applicant requests that the Examiner contact the undersigned attorney at the indicated phone number.

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